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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,481	11/25/2003	Robert P. Arentsen	ITTD-BG101US	5984

23122 7590 04/17/2007
RATNERPRESTIA
P O BOX 980
VALLEY FORGE, PA 19482-0980

EXAMINER

PRICE, CRAIG JAMES

ART UNIT	PAPER NUMBER
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3753

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
2 MONTHS	04/17/2007	PAPER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/721,481
Filing Date: November 25, 2003
Appellant(s): ARENTSEN ET AL.

MAILED
APR 17 2007
Group 3700

Robert P. Seitter
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/11/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is incomplete. A correct statement of the status of the claims is as follows:

Claims 1-22 and 26 are cancelled.

Claims 22-25 and 27-29 are rejected.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is deficient. 37 CFR 41.37(c)(1)(v) requires the summary of claimed subject matter to include: (1) a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number, and to the drawing, if any, by reference characters and (2) for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be

identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters. The brief is deficient because appellant has not provided the concise explanation for each independent claim (i.e. claims 22 and 27). The brief is also deficient because the appellant provides an incorrect explanation of the subject matter defined in independent claim 22. Appellant states that the valve assembly "includes a quarter turn valve, insert and rotatable flange after these parts have been fitted together, i.e., after the assembly is complete"; however, independent claim 22 recites, "the flange being freely rotatable relative to the insert and the valve housing **when** the insert is assembled to the valve housing".

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct. However, appellant appears to also argue the non-entry of the proposed amendment to the specification made after the final rejection. The proposed after-final amendment to the specification did not contain the same quoted wording of claim 22. Furthermore, the non-entry of an after-final amendment is a petitionable matter.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2002/0162986	ROCHELEAU	11-2002
3,241,810	KELLER III	3-1966

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 22 - 25 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 22 recites the limitation, "the flange being freely rotatable relative to the insert and the valve housing when the insert is assembled to the valve housing".

Paragraphs 29-34,36,37,39 in the detailed description discuss using the rotatable flange, but do not disclose that the flange can freely rotate when the insert is assembled.

Paragraph 29 lines 1-3 states that,

"(0029) Before coupling insert 102 to valve housing 100, the threaded end 103 of insert 102 is slipped through the central hole 115 formed in rotatable flange 106. The diameter of hole 115 is such that it snugly, but rotatably fits on the exterior of the insert."

The originally filed specification only has support for the free rotation before the device is in the finally assembled state. There is no support for the limitation if "when... assembled" is read as "after... assembled".

Claims 22, 24, 25, and 27 stand rejected under 35 U.S.C. 102(e) as being anticipated by Rocheleau (2002/0162986).

Regarding claims 22 and 27, Rocheleau discloses a quarter turn ball valve (8) including a valve housing (10) having inlet and outlet ports, an insert (16) having a body member including an exterior surface and an internal flow channel (Col.3, Lns.12-14), one end of the insert being coupled to the valve housing so that the internal flow channel communicates with one of the ports, a lip (16) formed on the free end of the body member, the lip being spaced from the valve housing when the insert is assembled to the valve housing, a flange (28) carried on the exterior surface of the insert between the lip and the valve housing, the flange being freely rotatable relative to the insert and the valve housing when the insert is assembled to the valve housing (Col.2, Lns.5-7), and fastener holes (30) formed in the flange for receiving fasteners that secure the valve assembly in a fluid system, and one end of said body member being fixed to the valve housing so that the exterior surface extends axially from the valve housing and the internal axial flow channel communicates with one of the ports and a flange having central opening formed therein of a size and shape complementary to the exterior surface of the insert so that the flange is spaced from the valve housing and freely rotatable on the exterior surface of the insert as shown in figure 6.

Regarding claim 24, Rocheleau discloses that the flange is formed with a mounting hole of a size and shape complementary to and larger than the exterior surface of the insert (Col.3, Lns. 12-14).

Regarding claim 25, Rocheleau discloses that the size of the mounting

hole is less than that of the lip (Col. 3, Lns. 12-14) as shown in figure 6 .

Claims 23, 28, and 29 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Rocheleau '986 in view of Keller III (3,241,810).

Rocheleau discloses all of the features of the claimed invention, but is silent to the end of the internal axial flow channel adjacent the lip is formed with a polygonal cross-section to accommodate a tool for threadably fixing the insert to the valve body.

Keller discloses a valve, which teaches the use of a polygonal cross-section (21) to accommodate a tool for threadably fixing an item, as shown in figure 2 (Col. 2, Lns. 41-48).

In view of the Keller patent, it would have been obvious to one of ordinary skill in the art at the time of invention to employ the hex shaped cross section of Keller into the insert of Rocheleau to have the end of the internal axial flow channel adjacent the lip is formed with a polygonal cross-section to accommodate a tool for threadably fixing the insert to the valve body in order to adjust the rate of flow of the valve (Col. 2, Lns. 51-55).

Claims 22 and 27 stand rejected in an alternative view, under 35 U.S.C. 103(a) as being unpatentable over Rocheleau '986.

Rocheleau teaches all of the features of the claimed invention, but discloses bolts to preclude movement of the rotatable flange.

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to remove the bolts so that the flange remains, since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art (see MPEP 2144.04).

(10) Response to Argument

Argument regarding claims 22, 24 and 25 – Rejection Under 35 U.S.C. 112, 1st

Paragraph

Initially, it is noted that appellant is only arguing the rejection of claims 22, 24, and 25, when claim 23 is also rejected under the same grounds. Therefore, if appellant is acquiescing the rejection of claim 23, it stands that the rejection as it pertains to claims 22, 24, and 25 should be sustained also.

Appellant argues that claims 22, 24 and 25 have not been rejected as containing new matter under 35 USC 132(a). Appellant appears to be under the impression that new matter rejections of claims are not made under 35 USC 112 1st paragraph. Appellant contends that since a rejection of the claims under 35 USC 132(a) has not been made, they can now enter an amendment to the specification that would cure the fact that new matter has been added to the claims that does not have support in the written description. This argument has no merit.

It is noted that a proposed specification amendment was filed, after final, which proposed adding the following language to the specification, "Rotatable flange 106 is carried on the insert 102 and is fully rotatable relative to the insert and the valve body 100 when the valve assembly is, in fact, an assembly, that is, after the insert, flange and valve body are fitted together. "

Appellant clearly recognized that the originally filed application was deficient in supporting the claim recitation that the flange was freely rotatable with respect to the insert and the valve housing after assembly by appellant's attempt to enter the support after final rejection. In the instance case, appellant is attempting to redefine "when assembled" to "after assembled" in order to avoid a prior art rejection. This attempt was made after appellant became aware of the prior art reference. Appellant was not in possession of the claimed invention at the time of filing if "when assembled" is read as "after assembled".

Appellant further argues that the parent application as originally disclosed supports the claim recitation in paragraph 24 because it states that a valve assembly includes a valve, insert, and rotatable flange. First, it is noted that the valve housing is not part of cited paragraph; so it is not clear how appellant feels that there is support for the recitation "when the insert is assembled to the valve housing". However, even if it did, appellant would require a meaning of "assembly" that contradicts a definition that appellant is citing in the appeal brief. Appellant cites dictionary definitions on page 13

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and 14. The first definition offered by appellant states that an assembly is "the fitting together of manufactured parts". Other dictionary definitions include "the putting together of complex machinery" from Dictionary.Com and " the act of assembling" from The American Heritage Dictionary.

That is, assembly means when the parts are being assembled (not after they are assembled as alleged by appellant).

Therefore, if appellant wants "when assembled" to mean "after assembled", the rejection of claims 22-25 under 35 USC 112 1st paragraph must be affirmed.

Claims 22, 24 and 25 – Rejection Under 35 U.S.C. 102(e)

Appellant argues that "the Rocheleau publication does not anticipate the subject matter of claims 22, 24, and 25. Claims 22, 24 and 25 take it a step further and drive home the point that the flange is "freely rotatable relative to the insert and the valve housing when the insert is assembled to the valve housing" (see claim 22). The Advisory Action states that "this [rotation] is considered to occur during assembly since the limitation does not explicitly state this action occurs after assembly" (see Advisory Action, Continuation of 11)."

Furthermore, Appellant argues that "It is submitted that the interpretation set forth in the Advisory Action is improper. Claims 22, 24 and 25 do not recite that the flange is

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rotatable when the valve assembly is being assembled - it recites a flange that is rotatable after it is assembled.”

Claim 22 recites that, “the flange being freely rotatable relative to the insert and the valve housing when the insert is assembled to the valve housing...”. There is no recitation that the flange is rotatable after assembly.

The 102 rejection of claims 22, 24, and 25 will stand or fall with the interpretation of the limitation “when...assembled”. There appears to be no argument that Rocheleau anticipates the claims if “when...assembled” is read as when it is assembled.

If this limitation is given the broadest reasonable consistent with the specification (and the dictionary definition given by appellant), then Rocheleau anticipates claims 22, 24, and 25 and the 102(e) rejection of claims 22, 24, and 25 should be affirmed (it should be noted that if the limitation is read in this manner, then the 112 1st rejection should be reversed).

Claim 27 – Rejection Under 35 U.S.C. 102(e)

Appellant argues that “Claim 27 recites a valve assembly comprising three basic components: (1) a quarter turn ball valve mounted in a housing; (2) an insert; and (3) a rotatable flange. Because claim 27 recites a valve assembly, the claim recites an assembled combination of these three basic components, i.e., after they have been

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Keller III valve stem with Applicant's insert" and that the "hexagonal section is not located at the free end of a flow channel".

The Keller III reference discloses a reciprocating adjustable valve, which teaches the use of a hexagonal shaped cross section, and, from the final rejection dated August 8, 2006, the closing paragraph is given as follows;

"In view of the Keller patent, it would have been obvious to one of ordinary skill in the art at the time of invention to employ the hex shaped cross section of Keller into the insert of Rocheleau to have the end of the internal axial flow channel adjacent the lip is formed with a polygonal cross-section to accommodate a tool for threadably fixing the insert to the valve body in order to adjust the rate of flow of the valve (Col. 2, Lns: 51-55). "

The Rocheleau reference was silent to having a hex shaped surface, therefore the Keller III patent was used to complete the intended structure set forth by the Appellant.

Claims 22 and 27 – Rejection Under 35 U.S.C. 103 (a)

Appellant argues that the rejection is improper for reasons already explained, and further states that "the rejection states that 'Rocheleau teaches all of the features of the claimed invention, but discloses bolts to preclude movement of the rotatable flange' and as noted earlier in this Appeal Brief, the flange disclosed in the Rocheleau publication is not rotatable after the valve parts are fit together, thus, the bolts do not preclude

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fitted together to form the claimed assembly. Thus, after the three components have been fitted together to form the claimed assembly, the flange is freely rotatable."

There is no limitation that recites the flange freely rotates after the device has been completely assembled.

The rejection of claim 27 will stand or fall with the interpretation of the limitation "assembly". The term assembly has been given the broadest reasonable interpretation during examination. "Assembly" was taken to mean that the device could be viewed as a group of parts in which the structure of the components were in the process of being assembled and were yet to be fully or completely assembled. This is consistent with the originally filed application as well as dictionary definitions.

Rocheleau's specification at Col. 2, lines 5-7 states: "The flange element may be allowed to rotate relative to the valve body during assembly to allow the installer to select a preferred orientation". The valve becomes an "assembly" as the parts are being put together. With this interpretation of "assembly", the rejection must be affirmed as Rocheleau anticipates the claims.

Claims 23, 28 and 29 – Rejection Under 35 U.S.C. 103 (a)

Appellant argues that Keller III does not address the deficiencies of the Rocheleau publication and that "there is no teaching, motivation or suggestion to combine the

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rotation, they clamp the valve assembly to the Hydronic circulator". The examiner disagrees. It is the bolts going through the flange that preclude the rotation of the flange with respect to the valve housing. It is only after the assembly of Rocheleau is mounted to another object that rotation of the flange is impossible.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Craig Price

Conferees:

Eric Keasel, SPE AU 3753



Kevin Shaver, SPE AU 3754

